

REMARKS

The Examiner rejected claims 1-4, 14-22 and 24-28 under 35 U.S.C. §102(e) as allegedly being anticipated by Henson et al.

The Examiner rejected claims 13 and 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619).

Applicants respectfully traverse the §102 and §103 rejections with the following arguments.

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35 U.S.C. §102

The Examiner rejected claims 1-4, 14-22 and 24-28 under 35 U.S.C. §102(e) as ~~allegedly~~ being anticipated by Henson et al.

Applicants respectfully contend that claims 1 and 19 are not anticipated by Henson, because Henson does not teach each and every feature of claim 1. For example, Henson ~~does not~~ teach or suggest the feature: "changing by the server a corresponding attribute of the ~~secondary~~ item in response to the change in the attribute of the primary item" (emphasis added).

The Examiner argues that Henson, col. 15, lines 31-45 teaches the preceding feature of claims 1 and 19.

Applicants offer the following example to illustrate why Henson, col. 15, lines 31-45 does not teach the preceding feature of claims 1 and 19. This example is structured in accordance with claims 1 and 19. In this example, the shopper has selected a primary item of a computer system having an attribute of being model C22, and this primary item is in the shopping cart. Then the shopper selects a secondary item of a hard drive having an attribute of being model I177, and this secondary item is also in the shopping cart. Next, the shopper issues a command that changes the attribute of the computer system in the shopping cart from model C22 to model C33. Then, in accordance with claims 1 and 26, the server changes the attribute of the hard drive in the shopping cart from model I177 to model H88, in response to the change the attribute of the computer system in the shopping cart from model C22 to model C33.

The preceding discussion illustrates what might happen if the method of claims 1 or 19 is performed. But what would happen with Henson after the shopper issues a command that changes the attribute of the computer system in the shopping cart from model C22 to model C33?

According to Henson, col. 15, lines 31-45, the configurator would display a menu of options to the shopper for selecting another hard drive to replace model H77. Then the shopper would make a selection from the menu of options to select hard drive model H88.

Thus, Henson falls short of teaching claims 1 and 19. The configurator of Henson does not change the attribute (i.e., model number) of the hard drive in the shopping cart, as required by claims 1 and 19. Instead, the configurator changes only a menu of hard drive model options. Applicants maintain that a menu of hard drive model options is not an attribute of the hard drive in the shopping cart. A hard drive is not characterized by a menu of hard drive model options. A menu of hard drive model options is only a list of possible model number for the hard drive in the shopping cart and is therefore not an attribute of the hard drive in the shopping cart. While a specific hard drive model number is an attribute of the hard drive in the shopping cart that can be possessed by the hard drive in the shopping cart, a menu of hard drive model options is not an attribute of the hard drive in the shopping cart, because the hard drive in the shopping cart cannot possess the menu of hard drive options.

By presenting a menu of hard drive model options to the shopper, the configurator (or server) is effectively assigning the task of changing the attribute (model number) of the hard drive in the shopping cart to the shopper. Since it is the server, and not the shopper, who must change the attribute (model number) of the hard drive in the shopping cart to satisfy claims 1 and 19, Applicants reiterate that Henson does not teach the preceding feature of claims 1 and 19.

Based on the preceding arguments, Applicants respectfully maintain that Henson does not anticipate claims 1 and 19, and that claims 1 and 19 are in condition for allowance. Since claims 2-4 and 14-18 depend from claim 1, Applicants contend that claims 2-4 and 14-18 are likewise in

condition for allowance. Since claims 20-22 and 24-28 depend from claim 19, Applicants contend that claims 20-22 and 24-28 are likewise in condition for allowance.

In addition with respect to claims 2 and 20, Henson does not teach the feature: "~~soliciting~~ and receiving by the server authorization from the shopper to change the corresponding ~~attribute~~ of the secondary item in response to the change in the attribute of the primary item".

The Examiner argues that Henson, col. 8, lines 7-55 teaches the preceding feature of claims 2 and 20.

In response, Applicants respectfully contend that in Henson, col. 8, lines 7-55, the ~~server~~ does no more than issue a warning to the shopper of an incompatibility in the shopper's ~~selection~~ of options. However, a warning of said incompatibility is not a solicitation for authorization to change an attribute of the secondary item, as confirmed by the Examiner's citation of Henson, col. 8, lines 53-55 ("The customer can then modify, change, and/or delete the particular option which gave rise to the validation warning. "). In other words, Henson teaches what the customer can do, but does not teach soliciting said authorization as required by claims 2 and 20.

Accordingly, claims 2 and 20 are not anticipated by Hanson.

35 U.S.C. §103

The Examiner rejected claims 13 and 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Henson and further in view of Chandramohan et al. (US Patent 6,711,619).

Since claims 13 and 23 respectively depend from claims 1 and 19, which Applicants have argued *supra* to not be unpatentable over Henson under 35 U.S.C. §102(c), Applicants maintain that claims 13 and 23 are likewise not unpatentable over Henson in view of Chandramohan under 35 U.S.C. §103(a).

In addition, with respect to claims 13 and 20, Henson in view of Chandramohan ~~does not~~ teach the feature: "wherein before said determining step, said method further comprising ~~the step~~ of: waiting by the server for said shopping command and continuing to wait by the server ~~for~~ said shopping command so long as said shopping command has not been received by the server".

The Examiner argues: "Chandramohan discloses the step of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server (see at least col.7, line 27-col.8, line 12," *FIG. 3A is a timing diagram that illustrates the method and operation of the present embodiment. As a background activity, the a-serve server module 101 monitors the network 146 (as shown in FIG. 1A) and waits for requests from a-serve client modules 103, as shown in element 306* "). In view of Chandramohan, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have incorporated the feature of awaiting by the server for said shopping command and continuing to wait by the server for said shopping command so long as said shopping command has not been received by the server because it is

well-known that the Transmission Control Protocol/Internet Protocol (TCP/IP) is a 'common networking protocol used for communication among computer-systems 100 that allows uniform formatting of data for transmittal and receipt and enabling the e-server to communicate with the client modules.'".

In response, Applicants respectfully contend that the Examiner's argument for modifying Henson by the alleged teaching of Chandramohan is not persuasive.

A first reason why the Examiner's argument for modifying Henson by the alleged teaching of Chandramohan is not persuasive is that the Examiner has not offered any evidence to support the Examiner's allegation that "it is well-known that the Transmission Control Protocol/Internet Protocol (TCP/IP) is a 'common networking protocol used for communication among computer-systems 100 that allows uniform formatting of data for transmittal and receipt and enabling the e-server to communicate with the client modules'". Applicants respectfully request that the Examiner supply evidence that supports the preceding allegation by the Examiner.

A second reason why the Examiner's argument for modifying Henson by the alleged teaching of Chandramohan is not persuasive is that, even if the preceding allegation by the Examiner is supported by evidence, the Examiner has not offered any evidence from the prior art as to why it is obvious to modify Henson by the alleged teaching of Chandramohan. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a

combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). The Examiner has not made any showing of where the prior art suggests the modification of Henson proposed by the Examiner. Thus, the Examiner has provided a reason for the combination by the Examiner's speculation, and not by teaching of the prior art. By not citing any suggestion or incentive in the prior art to support the Examiner's suggested modification of Henson, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 13 and 23.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending ~~claims~~ and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place ~~the~~ application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

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